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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,234	07/25/2003	John Erickson	1027.P004USC1	2437

29053 7590 07/27/2005

DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.  
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EXAMINER

FAULCON JR, LENWOOD

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/627,234	ERICKSON, JOHN	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lenwood Faulcon, Jr.	3762	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 6, 10, 13 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/22/2003</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 6, 10, 13 and 16 are objected to because of the following informalities: These claims state the repeating pattern of pulses comprise pulses repeating with a frequency between 2 and 5000 Hertz. It appears that "5000 Hertz" in the claims is a typo in light of the specification. Claims 6, 10, 13 and 16 will be interpreted to include the range of 2 to 500 Hertz. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 7-9, 21-22 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Gordon et al. (U.S. Patent No. 4,404,972).

Gordon et al. teaches of an implantable body function assist device, comprising a microprocessor that controls the response of the device to various external physiological events (col. 2 lines 34-37), a switch communicatively coupled to the microprocessor (col. 11 lines 1-6) and an implanted electrode lead (col. 9 lines 4-6). Gordon et al. also teaches of the microprocessor being adapted for use with a limited energy supply of a battery (col. 2 lines 37-42) and being contained within the implantable device for controlling pacer circuitry (col. 4

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lines 21-23). Gordon et al. further teaches that a clock circuit may be used for synchronizing pacer circuitry and the microprocessor (col. 4 lines 23-24).

Gordon et al. teaches that the microprocessor provides pulse control output signals to the pacer for setting the pulse parameter outputs (col. 4 lines 26-29) and further may be provided with additional memory capability to the microprocessor chip (col. 4 lines 31-34).

Gordon et al. also teaches of the use of a variety of counters to correspond to selected intervals relating to heart physiological characteristics (col. 6 lines 1-3). Gordon et al. further teaches of a counter for generated stimulation pulses (col. 13 lines 67-68, col. 14 lines 1-4). Gordon et al. also teaches of desired timeout intervals be provided by the operation of the microprocessor (col. 6 lines 8-10) and conserving energy by clocking timers at different pulse rates (col. 6 lines 11-12). Gordon et al. also teaches of conserving energy by minimizing the number of pulses required for various timeouts (col. 6 lines 39-47). Gordon et al. further teaches that microprocessor activates internal logic components in response to selected physiological events or at selected sample, or timeout, intervals, and further operates counters at a plurality of count rates in order to minimize power consumption (col. 16 lines 7-13).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 10-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon et al. (U.S. Patent No. 4,404,972).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the system as taught by Gordon et al. to have the system apply stimulation to various parts of a living body and for various applications, including a neurostimulator, since Gordon et al. teaches that system is an implantable body assist system, which is interpreted to include a neurostimulator (col. 1 lines 6-10, col. 2 lines 34-37). It would have also been obvious to one having ordinary skill in the art to modify the system as taught by Gordon et al. to have a repeating pattern of pulses comprise pulses repeating with a range of frequencies, including a range of 2-500 Hertz, since it common in the art to have such values, particularly as it is deemed necessary by the physician for the proper treatment of the patient. It would have further been obvious to one having ordinary skill in the art to modify the system as taught by Gordon et al. by having an external stimulation system, since the energy saving techniques taught by Gordon et al. would benefit be compatible and enhance the efficiency of the operation of external stimulation device by conserving energy.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Raddi et al. (U.S. Patent No. 3,738,371), Calfee et al. (U.S. Patent No. 4,390,022), Boute et al. (U.S. Patent No. 4,503,857), Bornzin et

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al. (U.S. Patent No. 5,476,483), Sandri et al. (U.S. Patent No. 5,745,352), Christopherson et al. (U.S. Patent No. 6,099,479), Thompson (U.S. Patent No. 6,223,080).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lenwood Faulcon, Jr. whose telephone number is 571-272-6090. The examiner can normally be reached on Monday-Thursday from 9 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D. Sykes, can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lenwood Faulcon, Jr.

  
George Manuel

Primary Examiner